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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,680	04/03/2002	Toshiharu Mitani	033235-002	5520

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EXAMINER

SINES, BRIAN J

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,680

Applicant(s)

MITANI ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the control factor" in line 22. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the control" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Regarding claim 1, it is unclear as to how the "control factor" is related to the data analysis (e.g., analysis deviation) and the preliminary production information and how it is utilized in obtaining control data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald et al. (U.S. Pat. No. 6,072,576 A) (hereinafter “McDonald”) in view of Frickel et al. (U.S. Pat. No. 6,820,013 B1) (hereinafter “Frickel”).

McDonald teaches on-line control of a chemical process plant. McDonald teaches a process control methodology using a Fourier Transform Near Infrared spectrometer (FTNIR) (see col. 3, lines 45 – 66). Measured, predictive and desired or setpoint values are compared and used for controlling the chemical process (see col. 1, line 46 – col. 2, line 5). McDonald teaches that the online monitoring method enables a prediction of the properties of the finished product. This prediction is then used to manipulate the inputs and the operating conditions of the process equipment to obtain finished products with the desired properties (see col. 3, lines 39 – 44). McDonald does not specifically teach a production control methodology not requiring the preparation of calibration curve plots. Frickel teaches a method for online chemical analysis in chemical production using near infrared spectroscopy (see col. 1, line 1 – col. 2, line 65). Frickel teaches that the method compares the absorbance spectrum of process samples measured during routine process operation to a reference database comprising absorbance spectrum of known samples (see col. 2, lines 5 – 35). The use of standard deviation analysis in data analysis

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is well known in the art. Furthermore, the specification of analysis ranges and wavelength interval selection in data processing and analysis, and including the second order derivative differentiation processing of absorbance spectrum, is well known in the art (see MPEP § 2144.03). Frickel teaches that the spectra are composed of the totality of individual spectral data points, the number of which depends both on the wavelength range used for the measurements and on the resolution of the spectrometer optical system (see col. 4, lines 39 – 65). Frickel teaches each data point is compared individually between the respective measured spectrum to be analyzed and the reference spectra present in the database, which implies that the preparation of calibration curve plots is not required (see col. 6, lines 47 – 51). Frickel teaches that by using principle component analysis (PCA) each full spectrum can be characterized by only a single characteristic number or control factor (see col. 3, lines 30 – 35; col. 8, lines 62 – 67). Frickel teaches that the disclosed method is suitable for process control applications (see col. 5, lines 10 – 23). Hence, as evidenced by Frickel, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success of incorporating the use of a process monitoring and control methodology not requiring the preparation of calibration curves. The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the use of a process monitoring and control methodology not requiring the preparation of calibration curves as claimed.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Brian J. Sines". The signature is stylized with a large, looping initial "B" and a long, sweeping underline.